

Remarks

This Application has been carefully reviewed in light of the Final Office Action mailed May 20, 2005. Applicant appreciates the Examiner's consideration of the Application. Although Applicant believes all claims are allowable without amendment, Applicant has made clarifying amendments to Claims 1, 3, 5-9, 11, 13-17, 19, 21-22, 24-25, and 28. At least certain of these amendments are not considered narrowing, and none is considered necessary for patentability. Independent Claim 29 and dependent Claims 2, 10, 18, and 23 have been canceled without prejudice or disclaimer. Additionally, Applicant has added new dependent Claims 30-35 and new independent Claim 36, none of which are believed to introduce any new matter. Applicant respectfully requests reconsideration and allowance of all pending claims and consideration and allowance of all new claims.

I. The Final Office Action Appears to be Incomplete

Applicant respectfully submits that the Final Office Action appears to be incomplete. In the Office Action Summary, the Examiner indicates that Claims 1-29 are rejected. The Final Office Action includes a substantive rejection of Claims 1, 7-8, and 17 (*see* Final Office Action, Pages 2-4); Claims 28-29 (*see* Final Office Action, Page 5); and Claims 2-6 and 18-27 (*see* Final Office Action, Pages 6-16), in that the Examiner indicates on what basis these claims are rejected. In contrast, the Final Office Action does not appear to include a substantive rejection of Claims 9-16. For example, the Examiner did not indicate in the Final Office Action the basis for the rejection of Claims 9-16, including at least the statutory section (e.g., 35 U.S.C. § 102 or 103) and the one or more references on which the rejection of these claims is based.

"In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and *any such grounds relied on in the final rejection should be reiterated.*" M.P.E.P. § 706.07 (emphasis added). Since no grounds of rejection were stated or reiterated in the Final Office Action with respect to Claims 9-16, and since the Final Office Action does not refer to any substantive rejection from the previous Office Action with respect to Claims 9-16 (*see id.*), Applicant respectfully submits that the Final Office Action is incomplete.

For at least these reasons, Applicant respectfully requests that, at a minimum, the Examiner issue a new Final Office Action that provides a substantive basis for rejecting Claims 9-16 and that resets the date for response.

II. The Claims are Allowable Over the Examiner's Rejections

A. Claims 1, 7-8, and 17 are Allowable

The Examiner rejects Claims 1, 7-8, and 17 under 35 U.S.C. 102(b) as being anticipated by Applicant's alleged "admitted related art," citing the section of Applicant's Specification entitled "Description of Related Art" (the "*Description of Related Art*"). (See Office Action, Page 2) Applicant respectfully disagrees.

At the outset, Applicant reiterates that the *Description of Related Art* sets forth background and related information with respect to Applicant's disclosure. Applicant has made no express or implied admission that the description included in the *Description of Related Art* qualifies as "prior art." Thus, Applicant maintains that the *Description of Related Art* does not provide a proper basis for rejecting Applicant's claims.

In any event, Applicant respectfully submits that the *Description of Related Art* does not disclose, teach, or suggest various limitations recited in Applicant's claims. Applicant discusses independent Claim 1 as an example.

For example, the *Description of Related Art* fails to disclose, teach, or suggest at least the following limitations recited in Claim 1 as amended:

- applying a condition test to each filter item of the filter, the condition test comprising:
 - determining if the filter item comprises a NOT connective; and
 - determining if the filter item comprises one of a type only filter item or a type and value filter item.

There is simply no disclosure, teaching, or suggestion in the *Description of Related Art* of "applying a condition test to each filter item of [a] filter," let alone applying a condition test that comprises "determining if the filter item comprises a NOT connective . . .

and determining if the filter item comprises one of a type only filter item or a type and value filter item,” as recited in Claim 1 as amended. At best, the *Description of Related Art* discloses applying a filter of a query to a data set in order to resolve the query.¹ (See, e.g., Page 2) While a filter as described in the *Description of Related Art* may include certain conditions for resolving a query, nowhere does the *Description of Related Art* disclose, teach, or suggest “applying a condition test to each filter item of [a] filter,” let alone applying a condition test that comprises “determining if the filter item comprises a NOT connective . . . and determining if the filter item comprises one of a type only filter item or a type and value filter item,” as recited in Claim 1 as amended. Applying the conditions of a filter to a data set to resolve a query of that data set fails to disclose, teach, or suggest applying any condition test to each filter item, let alone the particular condition test recited in Claim 1.

Additionally, Applicant respectfully submits that *Ciccareli* fails to make up for the deficiencies of the *Description of Related Art*. Based on the Examiner’s rejection of now-canceled dependent Claim 2, Applicant expects that the Examiner would cite Column 4, Line 65 through Column 5, Line 7 of *Ciccareli* as purportedly disclosing certain of the limitations now recited in amended Claim 1. Applicant respectfully submits that this cited portion of *Ciccareli* fails to disclose, teach, or suggest at least the above-discussed limitations as recited in Claim 1 as amended.

The cited portion of *Ciccareli* appears in a section of *Ciccareli* that describes Boolean operators (i.e., OR, AND, SUBTRACT) at a general level. (See Column 4, Line 46 through Column 5, Line 7) In particular, the cited portion of *Ciccareli* discloses that SUBTRACT is a type of Boolean operator and provides an explanation of the SUBTRACT operation. According to *Ciccareli*, the SUBTRACT operation (also known as the “AndNot” operator) takes a set of documents defined by an initial condition, then removes elements from that set which meet subsequent conditions. *Ciccareli* discloses that “baseball players and not Yankees” would be such a condition and would result in the set of all baseball players not on

¹ Applicant notes that it is not entirely clear which portion of the *Description of Related Art* that the Examiner relies on as allegedly disclosing “applying a condition test to each filter item to determine if the filter item includes a Not connective and if the filter item,” given that the Examiner’s citation is listed as “specification, page 2, line 15-page 2, line 10.” (Office Action, Page 3)

the Yankees. According to *Ciccarelli*, this is often easier than defining a condition which consists of many other expressions, which would be costly and slow to process. (See Column 4, Line 65 through Column 5, Line 7)

Applicant respectfully submits that at best the cited portion of *Ciccarelli* merely discloses how a NOT Boolean operation works. The cited portion of *Ciccarelli* fails to disclose, teach, or suggest “applying a condition test to each filter item of [a] filter,” let alone applying a condition test that comprises “determining if the filter item comprises a NOT connective . . . and determining if the filter item comprises one of a type only filter item or a type and value filter item,” as recited in Claim 1 as amended.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 17 and its dependent claims

B. Independent Claim 28 is Allowable

The Examiner rejects Claims 28-29 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,009,422 to Ciccarelli (“*Ciccarelli*”).

As Applicant noted above, independent Claim 29 has been canceled without prejudice or disclaimer. This cancellation is not made as a result of any reference cited by the Examiner.

Independent Claim 28 is allowable for at least certain reasons analogous to those discussed above with reference to independent Claims 1 and 17. In particular, *Ciccarelli* fails to disclose, teach, or suggest at least the following limitations recited in Claim 28, as amended:

- a condition tester operable to determine:
 - whether each filter item comprises a NOT connective; and
 - whether each filter item comprises a type only filter item or a type and value filter item.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 28.

C. Dependent Claims 3-6, 19-22, and 24-27 are Allowable

The Examiner rejects Claims 2-6 and 18-27 under 35 U.S.C. 103(a) as being unpatentable over Applicant's alleged admitted related art (i.e., *Description of Related Art*) in view of *Ciccarelli*. Applicant respectfully disagrees.

As discussed above, dependent Claims 2, 18, and 23 have been canceled without prejudice or disclaimer.

Claims 3-6 and Claims 19-22 and 24-27 depend from independent Claims 1 and 17, respectively, which Applicant has shown above to be clearly allowable, and are allowable for at least this reason. In addition, dependent Claims 3-6, 19-22, and 24-27 recite further patentable distinctions over the Examiner's proposed combination of the *Description of Related Art* and *Ciccarelli*. To avoid burdening the record and in view of the clear allowability of independent Claims 1 and 17, Applicant does not specifically discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicant does not admit that the proposed combination of the *Description of Related Art* and *Ciccarelli* is possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 2-6 and 18-27.

D. Claims 9 and 11-16 are Allowable

As indicated above, Applicant believes that the current Final Office Action is incomplete because it does not provide a substantive basis for rejecting Claims 9-16. Thus, Applicant respectfully requests that the Examiner issue a new Final Office Action that provides a substantive basis for rejecting Claims 9-16 and that resets the date for response.

In the previous Office Action, the Examiner rejected Claims 9-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ciccarelli* in view of the *Description of Related Art*. As a courtesy to the Examiner, Applicant will address the rejection of Claims 9-16 from the previous Office Action.

Applicant respectfully submits that independent Claim 9 is allowable for at least certain reasons analogous to those discussed above with reference to independent Claims 1 and 17. In particular, the proposed combination of *Ciccarelli* and the *Description of Related Art* fails to disclose, teach, or suggest at least the following limitations recited in Claim 9, as amended:

- condition test means operable to determine:
 - whether each filter item comprises a NOT connective; and
 - whether each filter item comprises one of a type only filter item or a type and value filter item.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 9 and its dependent claims.

E. New Claims 30-36 are Allowable

New dependent Claims 30-35 depend from independent Claim 28, which Applicant has shown above to be clearly allowable, and are allowable for at least this reason. In addition, dependent Claims 30-35 recite further patentable distinctions over the *Description of Related Art*, whether considered alone or in combination with *Ciccarelli*. To avoid burdening the record and in view of the clear allowability of independent Claim 28, Applicant does not specifically discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicant does not admit that the proposed combination of the *Description of Related Art* and *Ciccarelli* is possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references.

New independent Claim 36 is directed to software and is allowable for at least certain analogous reasons to those discussed above with reference to independent Claims 1, 9, 17,

and 28. Furthermore, Applicant respectfully submits that new Claim 36 does not recite any new matter.

For at least these reasons, Applicant respectfully requests consideration and allowance of new dependent Claims 30-35 and new independent Claim 36.

III. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Applicant hereby takes an extension of time for responding to the Final Office Action dated May 20, 2005 for one month from August 20, 2005 to September 20, 2005. A check in the amount of \$120.00 is enclosed to cover the extension of time fee. Additionally, a check in the amount of \$100.00 is enclosed to cover the cost of two new claims total over twenty. The Commissioner is hereby authorized to charge any other fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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